

REMARKS

I. Amendments to the Specification

The title has been changed to more precisely reflect the invention of the elected group.

II. Amendments to the Claims

Claims 1, 11, 13-14, 15, 17-20, 22, and 24-51 are pending; claims 2-10, 12, 16, 21, and 23 have been canceled (without prejudice or disclaimer). Applicants reserve the right to pursue the subject matter encompassed by all canceled claims in one or more divisional or continuation applications. New claims 25-51 have been added to claim embodiments that Applicants regard as the invention. New claims 25-51 are fully supported by the specification as originally filed and thus no new matter has been added.

Support for new claims 25-32 can be found, for example, on page 90, within Table 1, row 4, (Full length SEQ ID NO:83, clone HMADS41, and ATCC deposit number 209563); and for example, on page 109, lines 26-39 (minus methionine); and for example, on page 2, lines 25-31, and page 94, line 25 through page 95, line 25 (signal sequence, secreted polypeptide). Support for new claims 33-39 can be found, for example, on page 95, line 32 through page 96, line 11 (95% identical). Support for new claims 40-43 can be found, for example, on page 103, lines 5-14 (50 contiguous nucleotides). Support for new claims 44 and 48 can be found, for example, on page 106, lines 5-16 (fusion proteins). Support for new claims 45 and 49 can be found, for example, on page 107, line 29 through page 109, line 2 (vector). Support for new claims 46 and 50 can be found, for example, on page 108, lines 9-17 (operably associated). Support for new claims 47 and 51 can be found, for example, on page 109, lines 3-9 (host cell).

III. Provisional Election With Traverse:

The Examiner has required an election under 35 U.S.C. § 121 of one of Groups I to X. The Examiner contends that the inventions of the Groups are distinct, each from the other. The Examiner has also required a further election of a sequence from those listed in Table 1.

In order to be fully responsive, Applicants provisionally elect, *with traverse*, the subject matter of Group I, directed to, *inter alia*, polynucleotides. Applicants further

provisionally elect, *with traverse*, the polynucleotide of SEQ ID NO:38, and the polynucleotide of the HMADS41 cDNA contained in ATCC Deposit No. 209563 (*See* Table 1A, page 90, row 4). Applicants reserve the right to pursue the non-elected subject matter in one or more divisional applications. Applicants point out that claims 2-10, 12, 16, 21, and 23 have been canceled without prejudice or disclaimer, and that new claims 25-51 are directed to subject matter falling within the ambit of Group I as cast by the Examiner.

With respect to the Examiner's division of the invention into 10 groups and the reasons stated therefor, Applicants respectfully disagree and traverse.

Even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". *See* M.P.E.P. § 803. Applicants submit that in many instances, a search for publications disclosing a given protein will yield nucleic acids encoding the protein, antibodies to the protein, and methods of making and using the same. For example, a search of the reference H of the attached SB-08, Lonka et. al., would reveal information concerning the SEQ ID NO:38 polynucleotide, the polypeptide encoded by SEQ ID NO:38, and an antibody directed to the polypeptide encoded by SEQ ID NO:38. Since searches for a given protein, nucleic acids encoding such protein, antibodies to such protein, and methods of making and using the same commonly overlap, Applicants respectfully submit that the Examiner's assertion that the combined search and examination of such compositions and methods using the same would entail a serious burden has been rebutted, even assuming *arguendo* that the searches were not coextensive.

Accordingly, in view of M.P.E.P. § 803, the restriction should be modified so that the claims of all the groups directed to a particular sequence (e.g., Groups I-X) are searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn.

Further, if the restriction requirement is maintained, Applicants request rejoinder of the claims of Group I and VI once the claims of Group I are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official

Gazette which set forth new guidelines for the treatment of product and process claims. *See* 1184 OG 86 (March 26, 1996). Specifically, the notice states that:

in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

Id. *See* also M.P.E.P. § 821.04. Accordingly, Applicants respectfully request that if any of the claims of Group I, i.e., original claim 1 or new claims 25-59, are found allowable, then the process claim of Groups VI, claim 18, be rejoined and examined for patentability.

Furthermore, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

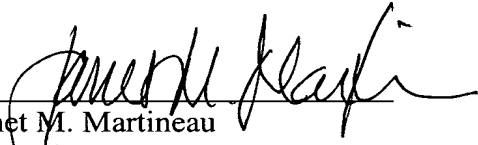
CONCLUSION

Applicants respectfully request that the amendments and remarks be entered and made of record in the file history of the instant application. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account.

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Respectfully submitted,

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